

REMARKS

Claims 1 - 17 have been canceled. Claims 18 - 34 have been added.

Procedural History

This application is a continuation of Application No. 08/149,193, filed November 8, 1993 ("the parent application"). In a March 23, 2001 Decision on Appeal in the parent application, the Board of Appeals and Interferences reversed all rejections of certain claims but let stand rejections of claims 119 and 132 of the parent application and entered new grounds of rejection against claims 123-127, 132, 133 and 138 of that application. The Board also effectively let stand an objection against claims 128 and 129 of the parent application.

New claims 18 - 26 correspond to claims 123 - 127, 130, 131, 133 and 138, respectively, of the parent application. New claims 27 - 37 are directed to subject matter somewhat similar to the subject matter of claim 18 - 20 and 22 - 26, respectively different wording.

With respect to the new grounds of rejection by the Board, applicant has elected to further prosecute those claims before the Examiner pursuant to 37 C.F.R. §1.196(b)(1) by filing the subject continuation application, while permitting the allowed claims to issue in the parent application.

Summary of the New Grounds Of Rejection by the Board

Claims 18-22 and 25 (corresponding to parent claims 123-127 and 133) have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 26

(corresponding to parent claim 138, but with amendments) was rejected under 35 U.S.C. §102(b) as being anticipated by Jordan, Jr., U.S. Patent 3,583,082.

Parent application claims 128 and 129, which have no counterparts in this application, had been rejected by the Examiner in the parent application as being duplicative of other claims now allowed by the Board. Claims 23 and 24 of this application correspond to parent claims 130 and 131, which stood allowable in the parent application but depended from claim 128.

Applicants' Response to the Rejections Under 35 U.S.C. §112

Claims 18-22 and 27 have been rejected under 35 U.S.C. §112, first paragraph, as being based on a disclosure that lacks descriptive support for the invention as claimed, and under 35 U.S.C. §112, second paragraph, as being indefinite. These rejections are respectfully traversed.

The Board, in making the rejections under 35 U.S.C. §112, has based the rejections on a novel and, respectfully, incorrect interpretation of 35 U.S.C. §112, sixth paragraph. Specifically, the Board has effectively held that a means-plus-function claim requires a description in the specification of the equivalents invoked by 35 U.S.C. §112, sixth paragraph. This turns the statutory language on its head and, not surprisingly, is contrary to precedent. See *In re Noll*, 545 F. 2d 141, 149-50, 191 USPQ 721, 727 (CCPA 1976) ("The meaning of 'equivalents' is well understood in patent law, and an applicant need not describe in his specification the full range of equivalents of his invention, some of which may be nonexistent at the time the application is filed." (citation omitted)). If a means-plus-function limitation is to be interpreted, as set forth in the statute, as "cover[ing] the corresponding structure... described in the specification and equivalents thereof," then by

definition, the equivalents are something not described *in haec verba* in the specification. *Noll*, 545 F.2d at 150, 191 USPQ at 727 (noting that section 112, sixth paragraph, equivalents “may be nonexistent at the time the application is filed”); see also *Texas Instruments, Inc. v. U.S. Int’l Trade Comm’n*, 805 F.2d 1558, 1568, 1568, 231 USPQ 833, 839 (Fed. Cir. 1986) (holding that the ALJ erred in limiting the structure corresponding to means-plus-function claim limitations to the embodiment disclosed in the specification because “[t]he statute, §112-6, was written precisely to avoid a holding that a means-plus-function limitation must be read as covering only the means disclosed in the specification”) (citation omitted). If a first embodiment is described, forming the “corresponding structure” of the statue, and equivalents also are described, those equivalents are in fact “corresponding structures,” and other, still undescribed, structures are the statutory equivalents. *Noll*, 545 F.2d at 149-50, 191 USPQ at 727.

Thus, in the rejection under 35 U.S.C. §112, first paragraph, the Board held that applicants introduced new matter by introducing means-plus-function claims covering undescribed equivalents. But if, as is the case by definition, one need not describe the equivalents, then means-plus-function claims always define undescribed subject matter. Yet the statute expressly permits such claims, and they cannot be rejected under 35 U.S.C. §112, first paragraph, as not being supported.

The Board apparently was of the opinion that the timing of the submission of the claims mattered. That is, since the means-plus-function claims were not in the application as filed, the Board reasoned that applicants added subject matter by adding mean-plus-function claims that, after the filing date, covered equivalents that were not previously

covered. However, "new matter" (35 U.S.C. § 132) is not the proper basis for a rejection; the only issue is whether the claim being considered is supported by the specification (35 U.S.C. §112, first paragraph). *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981) ("The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is §112, first paragraph, not §132"); *Noll*, 545 F.2d at 149, 191 USPQ at 727 (noting that a rejection based on the "lack of any corresponding descriptions of structure in the specification upon which the scope of equivalents might be based" is properly made under §112, first paragraph) (quotation omitted). As discussed above, the specification need not expressly recite the equivalents, and by definition cannot expressly recite them.

As long as there is at least one disclosed structure, applicant is entitled to a claim in means-plus-function format that covers that disclosed structure and its equivalents. As the CCPA stated in *Rasmussen*:

Section 132 prohibits introduction of new matter into the disclosure of an application. Section 112, first paragraph, requires that claim language be supported in the specification.

* * *

Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow.

Rasmussen, 650 F.2d at 1214, 211 USPQ at 325-26 (citations and emphasis omitted). By making timing an issue, the Board appears to be attempting -- inappropriately -- to resurrect the "late-claiming" doctrine disposed of almost twenty years ago by the Court

of Appeals for the Federal Circuit in *Railroad Dynamics, Inc. v. A. Stucki Co.*, 727 F.2d 1506, 1517, 220 USPQ 929, 940 (Fed. Cir. 1984).

Similarly, in the Board's rejection under 35 U.S.C. §112, second paragraph, the Board reasoned that because the equivalents covered by the means-plus-function claims are not disclosed, the scope of the claim is indefinite. As an initial matter, the CCPA has explicitly reversed a rejection on the these very grounds in *In re Noll*. *Noll*, 545 F.2d at 149-50, 191 USPQ at 727. Moreover, as noted above, equivalents, by definition, are never disclosed. Therefore, such claims cannot be rejected as indefinite if there is at least one corresponding structure clearly described in the specification. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999) ("All one needs to do in order to obtain the benefit of that claiming device [§112, sixth paragraph] is to recite some structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of [§112,] ¶ 2.").

For these reasons, claims 18-22 and 27 are in compliance with 35 U.S.C. §112, first and second paragraphs, and are therefore patentable.

Applicants' Response to the
Rejection Under 35 U.S.C. §102(b)

Parent application claim 138 was rejected by the Board under 35 U.S.C. §102 (b) as being anticipated by Jordan. Claim 26 corresponds to parent application claim 138, with amendments. This rejection is respectfully traversed.

Claim 26 defines a removable cleat in which a flange contacts turf being walked on and distributes weight over the turf, while protrusions from the flange provide traction against the turf, all without damaging or puncturing the turf.

The Board reasoned that at Jordan's lower bristle density limit of 10 per square inch, the "flange" would be exposed between the bristles and would distribute weight, while the bristles both support weight and provide traction. However, applicants respectfully submit that Jordan does not show or suggest the invention defined by claim 26.

Jordan teaches that the bristles themselves must be stiff enough to support a wearer's weight (column 2, lines 25-27). This is the only teaching in Jordan of anything supporting the wearer's weight. The only supporting of weight performed by Jordan's "flange" as disclosed is the indirect support resulting from the transmission of force longitudinally through the bristles to the flange. Jordan has no disclosure whatsoever that the "flange" contacts the turf to support weight as required by claim 26 (parent claim 138, as amended).

The Board relied on Jordan's description of its bristles "indenting" rather than "penetrating" a surface as a teaching that traction is provided without damaging turf as required by claim 26. However, Jordan has absolutely no teaching regarding turf at all, because Jordan is designed for running on cinder tracks. Moreover, one would not normally describe the effect of Jordan's bristles on grass or turf as "indenting"; although Jordan uses the term "indenting," the "indenting" that Jordan describes, when translated from hard cinder tracks to grass, must be viewed as "puncturing" within the context applicants' claim. For this reason, applicants stand by their assertion, quoted by the Board,

that "Only applicants/appellants realized that one could achieve traction without damaging penetration" (Appeal Brief, page 25; cited in Decision, page 28, n. 19).

As discussed above, the only fair reading of Jordan is that the weight of a wearer is borne solely by the bristles, and that the weight of a wearer standing on grass would be transmitted fully through bristles. If the Jordan cleats were used on turf, then, the Jordan bristles cannot help but penetrate at least to the soil, where at least some of the bristles must puncture the crowns of grass plants, because as they bear the wearer's full weight, the bristles must keep going, penetrating whatever is in their path, until the soil stops them.

Contrary to the Board's observation (Decision, page 31), the Jordan cleat is not "capable of performing as the claimed golf shoe cleat." If it were, then Dr. Victor A. Gibeault et al., reporting in 1983 on a study of how to provide traction on golf courses without the damaging effect of traditional metal spikes, would not have written:

"Is there a compromise? Is there some way out of this dilemma? In this technical age, anew idea for golf shoes may be lurking somewhere. Surely, it is possible to develop a shoe that will grip the ground without tearing the grass asunder."

Gibeault, V.A., et al., "Golf Shoe Study II," USGA Green Section Record, September/October 1983, pp. 6-7. This was twelve years after the issuance of Jordan. If the Jordan cleat in fact would have worked on grass as the Board suggested, then the conclusion of the study would have been different, and Gibeault would not have asked the question reproduced above, because the problem would have already been solved. The fact is, however, that the Jordan cleat does not solve the problem of providing traction without damage on golf courses or other grass surfaces, and does not meet applicants' claim 26.

Applicants respectfully submit that, for these reasons, claim 26 (parent claim 138, as amended) is patentable.

Claims 23 and 24

As set forth above, claims 23 and 24 correspond to allowed parent claims 130 and 131, which depended from parent claim 128.¹ The Board effectively affirmed the Examiner's objection to parent claim 128 (and parent claim 129) as duplicative of other claims allowed in the parent application.²

Claim 23 corresponds to parent claim 130, rewritten to incorporate parent claim 128. Claim 24 corresponds to parent claim 131. Neither claim 130 nor claim 131 stood rejected following the Decision of the Board in the parent application, nor was either claim objected to. Accordingly, claims 23 and 24 are allowable.

Claims 27 -34 are patentable for the same reasons set forth above on behalf of claims 18 - 20 and 22 - 26, respectively. Claims 27 - 31 differ from claims 18 - 20 and 22 - 23, respectively, primarily by eliminating all means-plus-function language. Claims 32 and 33 are identical to claims 24 and 25, respectively, but depend from claim 30. Claim 34 differs from claim 26 in requiring that the traction elements that extend downward beyond the lower flange surface be formed as part of a unitary plastic body with the flange.

¹Parent claim 131 depended from parent claim 130, which depended from parent claim 128.

²The Examiner had rejected parent claims 128 and 129 under 35 U.S.C. § 101 for statutory double-patenting because they were duplicative of other claims. The Board stated that the duplicative nature of the claims was better dealt with as an objection under 37 C.F.R. §1.75.

SECRET

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